

Serial No.: 09/365,747  
Art Unit : 3723

Docket No. 15066.00

### REMARKS

By the present amendment, Applicant has made minor revisions to the specification to correct inadvertent mistakes and to more particularly describe the present invention. Care has been exercised to ensure that no new matter be introduced by the present amendment to the written description. Further, Applicant has amended Claims 1-3, 5, 8 and 17-18, cancelled Claims 4, 7 and 9-16, and added Claims 19-20. Claims 1-3, 5-6, 8 and 17-20 remain pending in the present application. Claim 1 is the sole independent claim. Reconsideration of the application in light of the present amendment and following remarks is respectfully requested.

#### The Interview

Applicant appreciates the courtesies extended to his representative during the personal interview held on October 31, 2000. The present response summarizes the substance of the interview. At the interview a proposed amendment to the specification and claims was presented for discussion, and a prototype of Applicant's invention was demonstrated. Proposed amended Claim 1 set forth a carabiner/tool combination device including a curvilinear body having an elongated handle member with a first end and a second end, an upper arm member integrally attached at the first end, and a lower arm member integrally attached to the second end of the handle member. The claimed combination device was further defined as including an elongated storage slot disposed within the handle member, a knife blade pivotally mounted at the first end of the handle member, and a gate element connecting the upper arm and lower arm members.

Additional features set forth by the proposed claims include the pivoting movement of the blade and gate element between an open and closed position and the prolate opening defined by the carabiner body. Applicant's representative argued that the prior art of record failed to reasonably suggest a combination carabiner/knife tool having the structural features as defined by the proposed amended claims. The Examiner indicated approval of the revisions to the specification and stated that the indefiniteness rejection under 35 U.S.C. 112 was obviated by the proposed amendment of Claim 1. However, the Examiner indicated that the obviousness rejection of record would be maintained, despite Applicant's arguments as to the factual and legal tenuousness of this position.

The Office Action

In Paper No. 3, the Examiner objected to the drawings as failing to comply with 37 CFR 37 CFR 1.83(a). Claims 1-18 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 2 and 4-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weiss et al. in view of Myerchin or further in view of Collins, Applicant's IDS, Deweese, or Wurzer. Claim 3 was indicated as being allowable if rewritten in independent form.

The Drawings

The Examiner indicated that the "arcuate slot" recited in Claim 3 was not shown in the drawing. In this regard, Applicant has amended the specification at page 13 to recite "arcuate slot 40s" as clearly shown in Fig. 3. Applicant submits that the drawings are now in compliance with 37 CFR 1.83(a).

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The "Notice of Draftsperson's Patent Drawing Review" (PTO Form - 948) was not included as an attachment with the recent Office Action. Applicant requests that this form be included with the next Office communication so that any informalities to the original drawings under 37 CFR 1.84 can be corrected.

The Section 112 Rejection

Applicant has amended independent Claim 1 to more particularly define the subject matter in question. Specifically, the terms "upper loop region" and "lower loop region" have been changed to the more descriptive terms --upper arm member-- and --lower arm member--, respectively. Corresponding revisions to the specification have been made to provide express antecedent basis for the presently recited terms. In addition, the specification at page 13 has been amended to provide proper antecedent support for the "arcuate slot" recited in claim 3 and specifically illustrated in Fig. 3. Applicant respectfully submits that Claims 1-3, 5, 6, 8 and 17-20, as presently appearing in the application, meet the specific requirements of 35 U.S.C. § 112, second paragraph.

The Prior Art Rejections

The cancellation of Claims 4, 7 and 9-16 serves to render the prior art rejections of record moot with respect to these particular claims. With regard to the remaining claims, Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art.

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The Examiner's indication of allowable subject matter is noted with appreciation, but for the reasons as argued at the aforementioned interview and as supplemented herein, Applicant's strongly feels that he is entitled to patent protection for the invention encompassed within the scope of independent Claim 1, as amended. Amended Claim 1 correspond to that presented at the interview and sets forth, in general, a combination tool device including a carabiner having a handle member with an storage slot therein and a knife blade pivotally mounted at the first end of the handle member. New Claim 19 is directed towards Applicant's combination tool device, wherein at least one tool is pivotally mounted at the second end of the handle member, and new Claim 20 generically defines this tool in a Markush grouping. The claimed carabiner/knife combination device is particularly useful for those persons engaging in mountaineering and rock climbing. Applicant respectfully submits the combined teachings afforded by the prior art of record fails to reasonably suggest Applicant's combination tool as defined by the present claims.

The primary reference to Weiss et al. discloses the use of a carabiner structure as an openable handle for integral attachment to a transportable object. Weiss' handle has a gate-like opening to permit full-handed gripping use of the portable object. The primary reference lists as exemplary objects for use with the openable handle attachment such cylindrical items as air tanks, thermos bottles, and umbrellas, in addition to the mugs and flashlights specifically illustrated. While the Weiss et al. patent generally discloses that the carabiner handle attachment may be applied to a wide variety of portable objects, this reference specifically teaches that the handle attachment is intended to be used in the same manner as a conventional handle for the object attached thereto. Note Col. 2, lines 36-40 and 53-56. Clearly, one skilled in the art

would not be persuaded to substitute a knife for any one of the cylindrical objects realistically taught by Weiss et al. since a knife could not be used effectively by gripping the openable handle of the reference. Moreover, Applicant's knife is conveniently operated by gripping the claimed handle member which is disposed opposite the gate element.

In order to supplement the apparent deficiency of the primary reference to Weiss et al. et al., the Examiner relies upon the secondary reference to Myerchin et al., which merely shows a pocketknife with an integral light. Notwithstanding the structural and functional distinctions between the carabiner/flashlight combination disclosed by the primary reference and the knife/light combination of the secondary reference, the Examiner concludes that it would have been obvious "to substitute the flashlight of Weiss et al. with the knife and flashlight as taught by Myerchin et al. to carry extra tool with ease" (*sic*). Applicant submits that there appears no motivation or guidance in the prior art to combine the references in the manner suggested of record. In fact, the prior art teaches away from modifying the carabiner/flashlight of the primary reference as suggested by the Examiner for the reasons as delineated supra. Applicant's knife is disposed within the storage slot of the handle member and may not be conveniently manipulated by gripping the carabiner structure as taught by Weiss et al. Thus, one skilled in the art would necessarily conclude that a knife would not function equivalently to the portable objects realistically taught by the primary reference. Moreover, Applicant contends that even if the references were properly combined, one skilled in the art would not be able to arrive at the presently claimed invention without recourse to Applicant's own disclosure.

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Under Section 103(a), there must be some objective teaching in the prior art that would have motivated one of ordinary skill in the art to arrive at the claimed invention as a whole. In re Fine, 5 USPQ2d 1596, 1599-1600 (Fed. Cir. 1988). The combined teachings afforded by the prior art of record are insufficient to support the obviousness rejection within the meaning of 35 USC § 103(a) since there appears no suggestion or motivation from the prior art as a whole for a person of ordinary skill to have combined or modified the references in the manner suggested by the Examiner. Further, the references of record do not reasonably suggest Applicant's knife/carabiner tool having the specific combination of features called for by the present claims. The secondary references to Collins, Applicant's IDS, Dewese and Wurzer further relied upon by the Examiner have been duly considered, but add nothing substantive to the noted deficiencies of Weiss et al. and Myerchin et al. The fact that one of ordinary skill in the art may have the capabilities to arrive at Applicant's claimed combination tool is not the proper test for whether one would arrive at the invention based on the teachings of the prior art. Applicant respectfully submits that for at least these reasons, independent Claim 1, as amended, and corresponding dependent Claims 2, 3, 5, 6, 8 and 17-20 are allowable over the prior art applied of record.

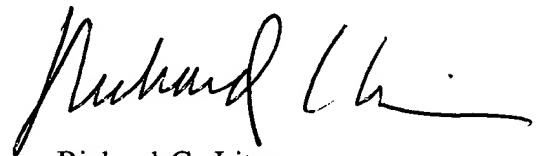
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### Summary

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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